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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,426	07/24/2003	Edward B. Knudson	UV-34 Div 2 Con 4	2337
75563 7590 03/29/2010 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER ATALA, JAMIE JO	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 03/29/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/627,426		KNUDSON ET AL.	
	Examiner		Art Unit	
	JAMIE JO ATALA		2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/8/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
|--|--|

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 8, 2010 have been fully considered but they are not persuasive. On pages 2-3 applicant argues the prior art of record fails to disclose "select television program is received with copy protection from a television distribution facility" as recited in Claim 1. It is noted Wonfor et al teaches a system wherein information pertaining to copy protection is sent from the video service providers and PPV providers wherein meets the limitation of "television distribution facility". Furthermore, applicant argues the prior art fails to disclose or teach means for (a) removing the copy protection from the selected program (b) providing the selected program without copy protection, and (c) directing the video recorder to record the selected program when the program is purchased at the price for the program without copy protection as recited in Claim 1. It is noted that Wonfor et al additionally teaches providing copy protection (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Therefore, the copy protection is controlled by a television distribution center as the headend/uplink software communicates the on/off mode for the copy protection to provide adequate access and control to the video programming. Although, all of applicants points are understood the examiner can not agree and thereby the rejection is maintained.

2. . Claims 5-12 are currently pending. Claims 1-4 have been cancelled on August 6, 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5,7,9,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (6,412,110) in view of Wonfor et al (US 6,381,747).

[claim 5]

In regard Claim 5, Schein et al discloses an interactive program guide system including user equipment with which an interactive television program guide is provided and which includes a video recorder and a television (Figure 1), comprising:

- means for receiving television program guide information for use in the interactive television program guide (Figure 1 and described in Column 4 Lines 6+);
- means for displaying the interactive television program guide (Figure 1);
- means for providing a user with a first opportunity to select a program for recording and a second opportunity to select the program for viewing selecting a

program for recording or for viewing from the interactive program guide (Figure 1 shows the ability to select or to record (button 208) through the interactive program guide);

- means for receiving the selected program with copy protection from a television distribution facility (Column 10 Lines 62+ describes the receiving of pay-per-view program and thus content with copy protection signal encoded into the signal);
- means for offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording (Column 10 Lines 60+ through Column 11 Lines 1-44 describes the offering of content with and without copy protection); however, fails to disclose
 - means for (a) removing the copy protection from the selected program (b) providing the selected program without copy protection, and (c) directing the video recorder to record the selected program when the program is purchased at the price for the program without copy protection;
 - means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing
 - means for providing the selected program with copy protection when the program is purchased at the same price for the program with copy protection

Wonfor et al teach a method of controlling copy protection in digital video networks where it is desired to copy protect an analog or digital video output signal associated with a digital video network, comprising displaying the interactive television

program guide (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Displaying the interactive television program guide provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and removing the copy protection from the selected program provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs. Furthermore, Wonfor et al teaches the means for offering a selected purchase at a price that provides copy protection (Column 2 Lines 45+ through Column 3 Lines 1-40) wherein the system determines process based on desired content by user. Although, Wonfor et al fails to explicitly disclose means for offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording, means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing, and means for providing the selected program with copy protection when the program is purchased at the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

Therefore, would have been obvious to one of ordinary skill in the art at the time of the invention to use Schein et al to provide an interactive television guide and further provide a system that provides pricing information based on content and copy protection of the content, as taught by Wonfor, in order to provide the desirable advantage of

allowing the user to have access to the programs in order to copy desired programs and to protect the broadcast content.

[claim 7]

In regard to Claim 7, Schein et al discloses an interactive program guide system including user equipment with which an interactive television program guide is provided and which includes a video recorder and a television (Figure 1), comprising:

- receiving television program guide information for use in the interactive television program guide (Figure 1 and described in Column 4 Lines 6+);
- displaying the interactive television program guide (Figure 1);
- providing a user with a first opportunity to select a program for recording and a second opportunity to select the program for viewing selecting a program for recording or for viewing from the interactive program guide (Figure 1 shows the ability to select or to record (button 208) through the interactive program guide);
- receiving the selected program with copy protection from a television distribution facility (Column 10 Lines 62+ describes the receiving of pay-per-view program and thus content with copy protection signal encoded into the signal);
- offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording (Column 10 Lines 60+ through Column 11 Lines 1-44 describes the offering of content with and without copy protection); however, fails to disclose

- removing the copy protection from the selected program providing the selected program without copy protection, and directing the video recorder to record the selected program when the program is purchased at the price for the program without copy protection;
- offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing
- providing the selected program with copy protection when the program is purchased at the same price for the program with copy protection

Wonfor et al teach a method of controlling copy protection in digital video networks where it is desired to copy protect an analog or digital video output signal associated with a digital video network, comprising displaying the interactive television program guide (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Displaying the interactive television program guide provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and removing the copy protection from the selected program provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs. Furthermore, Wonfor et al teaches the means for offering a selected purchase at a price that provides copy protection (Column 2 Lines 45+ through Column 3 Lines 1-40) wherein the system determines process based on desired content by user. Although, Wonfor et al fails to explicitly disclose means for offering the selected program for purchase at a price for the program without copy protection when

the program is selected for recording, means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing, and means for providing the selected program with copy protection when the program is purchased at the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

Therefore, would have been obvious to one of ordinary skill in the art at the time of the invention to use Schein et al to provide an interactive television guide and further provide a system that provides pricing information based on content and copy protection of the content, as taught by Wonfor, in order to provide the desirable advantage of allowing the user to have access to the programs in order to copy desired programs and to protect the broadcast content.

[claim 9]

In regard to Claim 9, Schein et al disclose an interactive program guide system including user equipment with which an interactive television program guide is provided and which includes a video recorder and a television (Figure 1), comprising:

- communications circuitry configured to receive television program guide information for use in the interactive television program guide (Figure 1 and described in Column 4 Lines 6+);
- display circuitry configured to display the interactive television program guide (Figure 1);

- circuitry configured to receive a program with copy protection from a television distribution facility(Figure 1 shows the ability to select or to record (button 208) through the interactive program guide);
- circuitry configured to remove copy protection from received programs (Column 10 Lines 62+ describes the receiving of pay-per-view program and thus content with copy protection signal encoded into the signal); and
- control circuitry configured to provide a user with a first opportunity to select a program for recording and a second opportunity to select the program for viewing from the interactive television program guide (Figure 1); direct the display circuitry to display a message offering the user the selected program for purchase at a price for the program without copy protection when the program is selected for recording (Figure 1 shows the image for recording wherein if pay-per-view is selected can determine price); direct the tuner circuitry to tune to the selected program with copy protection (Column 10 Lines 60+ through Column 11 Lines 1-44 describes the offering of content with and without copy protection); however, fails to disclose
 - direct the circuitry to remove the copy protection from the selected program and provide the selected program without copy protection and a video recorder to record the selected program without copy protection when the program is purchased at the price for the program without copy protection,

- direct the display circuitry to display a message offering the user the selected program for purchase at a price for the program with copy protection when the program is selected for viewing,
- direct the tuner circuitry to provide the selected program with copy protection when the program is purchased at the price for the program with copy protection.

Wonfor et al teach a method of controlling copy protection in digital video networks where it is desired to copy protect an analog or digital video output signal associated with a digital video network, comprising displaying the interactive television program guide (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Displaying the interactive television program guide provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and removing the copy protection from the selected program provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs. Furthermore, Wonfor et al teaches the means for offering a selected purchase at a price that provides copy protection (Column 2 Lines 45+ through Column 3 Lines 1-40) wherein the system determines process based on desired content by user. Although, Wonfor et al fails to explicitly disclose means for offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording, means for offering the selected program for purchase at a price for the program with copy protection when the program is selected

for viewing, and means for providing the selected program with copy protection when the program is purchased at the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

Therefore, would have been obvious to one of ordinary skill in the art at the time of the invention to use Schein et al to provide an interactive television guide and further provide a system that provides pricing information based on content and copy protection of the content, as taught by Wonfor, in order to provide the desirable advantage of allowing the user to have access to the programs in order to copy desired programs and to protect the broadcast content.

[claim 11]

Regarding Claim 11, the claim limitations have been discussed in Claim 7.

5. Claims 6, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (6,412,110) in view of Wonfor et al (US 6,381,747) in further view of Schull (US 5,509,070).

[claim 6]

In regard to Claim 6, Wonfor et al teaches the price of content (Column 2 Lines 45+ through Column 3 Lines 1-40); however, fails to disclose wherein the price for the program without copy protection is more than the price for the program with copy protection. Schull teaches copy protection techniques wherein the price and

complexity of the copy protection is based on price. Thereby a lower cost of copy encouragement/without copy protection allows for users with legitimate purposes to copy to pay a higher fee to have the copies available (Column 1 Lines 54+ through Column 2 Lines 1-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the interactive program guide, as disclosed by Schein et al in view of Wonfor et al, and further incorporate a price based on complexity and copy protection, as taught by Schull, in order to allow proper access to those needing copies of the material.

[claim 8]

In regard to Claim 8, claim limitations have been discussed in claim 6.

[claim 10]

In regard to Claim 10, claim limitations have been discussed in claim 6.

[claim 12]

In regard to Claim 12, claim limitations have been discussed in claim 6.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

3. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE JO ATALA whose telephone number is (571)272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMIE JO ATALA/

Primary Examiner, Art Unit 2621